

THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB

March 30, 2004
Paper No. 17
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Locus Technologies

Serial No. 75733593

Rochelle D. Alpert and Savita N. Krishna of Brobeck,
Phleger & Harrison for Locus Technologies.

Bridgett Garrett Smith, Trademark Examining Attorney, Law
Office 115 (Tomas Vlcek, Managing Attorney).

Before Walters, Bottorff and Holtzman, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Locus Technologies filed an application on the
Principal Register to register the mark EIM for "managing
software, namely software for analysis, monitoring,

management, remediation, containment, assessment and treatment of toxic materials,"¹ in International Class 9.

On January 9, 2001, following a refusal to register on the ground that the mark is merely descriptive, applicant amended the application to the Supplemental Register.

The Examining Attorney has issued a final refusal on the ground that the specimens are unacceptable evidence of trademark use, under Section 1051(a)(1)(C) of the Trademark Act, 15 U.S.C. 1051(a)(1)(C) and Trademark Rule 2.56, 37 CFR 2.56.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

During examination of the application and in her final refusal the Examining Attorney contended that the specimens are unacceptable because they consist of brochures, which are not acceptable evidence of use of a mark in connection with goods. She suggested that appropriate specimens would include, *inter alia*, labels, tags or instruction manuals.

With its July 11, 2001, request for reconsideration, applicant submitted substitute specimens² consisting of an

¹ Serial No. 75733593, filed June 21, 1999, based on use in commerce, alleging first use and first use in commerce as of May 1, 1997.

² Upon submission, applicant characterized the new specimens as "additional" specimens. However, in its appeal brief, applicant states

excerpt from its website with the mark therein.³

Additionally, applicant submitted a copy of an article from an online publication, *MicroTimes.com* (www.MicroTimes.com, July 10, 2001), in support of its position that this type of specimen should be acceptable in applicant's business. Without explanation, the Examining Attorney issued a brief denial of reconsideration.

The Examining Attorney contends in her brief that the specimens submitted are merely advertising materials that are not acceptable evidence of trademark use; that the specimen, a web page excerpt, merely describes and advertises applicant's product; that there is nothing on the web page that provides ordering information; that labels or the like would be appropriate specimens because "computer software is extremely easy to tag or label in standard fashion as it normally comes on diskettes or CD-

that the only issue is whether its web page is an acceptable specimen. Thus, we have treated this specimen as a "substitute" specimen. However, we note that it is well established that advertising matter such as that submitted originally with the application is not an acceptable specimen unless applicant establishes that it is a point of purchase display or information included with the instruction manual or packaged product. See, *In re MediaShare Corporation*, 43 USPQ2d 1304 (TTAB 1997).

³ The website excerpt is dated July 10, 2001, which is subsequent to the filing date of the application. However, given the very nature of websites, we cannot expect applicant to be able to produce a printout of an earlier version of the website. Thus, because the submission includes applicant's verified statement that this evidences use of the mark on the goods prior to the application filing date, we find the submission to be representative of its website prior to the filing date of the application.

ROMS"; and that "applicant never raised the possibility that 'routine' or 'ordinary' specimens were impracticable." (Brief, unnumbered p. 3.)

Applicant contends that the web page specimens prominently display the EIM mark; that "it is implicit on the applicant's web page that any one interested in the EIM software can sign up by contacting the applicant and means exist on applicant (*sic*) web pages to contact the applicant"; that "a customer purchasing the EIM software does not receive a package with the software, but rather subscribes to use the EIM software ..."; and that the "submitted specimens contain far more than a listing of specifications and are part of the 'sale' of the EIM software" (Excerpts from Applicant's Brief, pp. 2-4.)

Applicant argues that its situation is analogous to *In re Ultraflight, Inc.*, 221 USPQ 903 (TTAB 1984) because its web page is essentially a display associated with the goods; and to *Lands End, Inc. v. Manbeck*, 797 F.Supp. 311, 24 USPQ2d 1314 (E.D. Va. 1992), because its web page is akin to a catalog.

The above-referenced article submitted by applicant from *MicroTimes.Com* (Issue 220, April 16, 2001) is entitled "Outsourced Web Business Apps" and indicates that many small to mid-size businesses are outsourcing various

applications, such as billing and customer care to application service providers (APSS); that APSS provide business infrastructure for such businesses; and that these applications are run over the Internet and are accessible from any browser. The article states, in part, the following:

Clearly, there are many compelling reasons why more organizations, especially small to midsize enterprises, are renting applications over the Web rather than developing them in-house or buying the shrink-wrapped version.

Jeff Matson ... says that companies simply can't afford the risk of "being locked into a technology that becomes obsolete before it arrives on the loading dock."

Applicant describes its business and goods⁴ as follows

[*citations and footnotes omitted*]:

Applicant Locus Technologies provides EIM software, available on its servers accessed through the Internet, *which its customers could not otherwise afford to operate and manage.* [*Italics in original.*]

... As demonstrated in the specimens the EIM software consists of multiple software modules which a customer can access at applicant's web site with a password via the Internet to obtain a form (for operating the software) that will meet the client's requirements without the customer hiring an IT staff familiar with the environmental management.

These submitted specimens contain far more than a listing of specifications and are part of the

⁴ Applicant's identified goods are not limited to downloadable or Internet-accessed software. Therefore, as identified, applicant's goods encompass software on CD-ROM and diskettes as well.

"sale" of the EIM software to clients (customers).... Using applicant's web pages, containing the submitted specimens, allows a customer to order the EIM software and thereafter utilize it with a password.

The issue before the Board is whether the specimen in this application is an acceptable specimen of use of the mark EIM for the identified software. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "use in commerce" on goods as when "(A) it [the mark] is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce ..."

Trademark Rule 2.56, 37 CFR 2.56, regarding the requirements for specimens reads, in pertinent part, as follows:

- (a) An application under section 1(a) of the Act, an amendment to allege use under §2.76, and a statement of use under §2.88 must each include one specimen showing the mark as used on or in connection with the goods, or in the sale or advertising of the services in commerce.
- (b) (1) A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

The *Trademark Manual of Examining Procedure (TMEP)* (Third edition January 2002--R-2 May 2003) §904.04(d), regarding specimens for "downloadable" software, states the following⁵:

For downloadable computer software, the applicant may submit a specimen that shows use of the mark on an Internet website. However, such a specimen is acceptable only if the specimen itself indicates that the user can download the software from the website (e.g., if the specimen shows a download button). If the website simply advertises the software without providing a way to download it, the specimen is unacceptable.

The courts and the Board have been quite clear that, in assessing the acceptability of materials which have been submitted as specimens of use, the facts and surrounding circumstances must be fully evaluated to determine the acceptability of preferred specimens. See, e.g., *Lands' End Inc. v. Manbeck*, *supra*; *In re Ancha Electronics Inc.*, 1 USPQ2d 1318 (TTAB 1986); *In re Shipley Co. Inc.*, 230 USPQ 691 (TTAB 1986); *In re Ultraflight Inc.*, *supra*; and *In re Brown Jordan Co.*, 219 USPQ 375 (1983). Applicant has clearly explained its goods, which are not in tangible form, but rather exist only via the Internet. Thus, it is impracticable (perhaps impossible) for these goods to be

⁵ While the software involved herein does not appear to be "downloadable" per se, it is "accessible" only via the Internet and, thus, is analogous to downloadable software for the purpose of determining the acceptability of specimens.

marked with a tag or label in any traditional sense, including either as a document or a display associated with the goods.

Further, we are not bound by the *TMEP*, which is a manual of procedure and does not carry the same force as the law and the rules. See *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, fn. 8 (Fed. Cir. 1994); and *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1035 (TTAB 1996). In this regard we note that the policy cited above in *TMEP* §904.04(d) with regard to downloadable software cites to no authority in support thereof. The Board can find no authority to support the theory that if "downloadable" software is not downloadable directly from a "button" appearing on a web page, then it may only be considered to be advertising.

In the case before us, there is no "button" to directly access the EIM software. We do not consider this a "fatal" flaw in the specimen. However, considering the specimen in its entirety, other than the web address that this specimen represents, the material submitted contains no address, phone number, email address⁶ or other means for

⁶ Applicant contends that the specimen does contain an email address, but it is merely the address of the "webmaster" for general comments

contacting applicant; it is not a portal for accessing the software; nor does it show a reproduction of actual screen(s) from the running software program. It is merely a three-page description of the software, its design and application, that includes the product name, EIM, and touts its benefits to prospective purchasers. Contrary to applicant's contentions, we find nothing on this web site as shown that would permit us to conclude, even by analogy, that the specimen is a point-of-sale presentation or that it is a "catalog page."⁷

Decision: The refusal to register based on a requirement for an acceptable specimen is affirmed.

about the web site. Applicant suggests that contact information is implicit, although such information is difficult to infer without more.

⁷ The web page does contain several pull-down screens and three "diamonds" with words thereon. However, this matter is so small and indistinct as to be unreadable. Moreover, apparently applicant did not consider this matter important enough to mention it or to explain what it shows. Thus, we have not considered this information to be of any significance to the issue before us.